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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,275	07/11/2003	Ronald Paul Dean	10017961-2	4838

7590 02/15/2005

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EXAMINER

LE, TAN

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary	Application No.	Applicant(s)
	10/618,275	DEAN ET AL.
Examiner	Art Unit	
Tan Le	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 November 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-16 and 21-24 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/21/2003.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

DETAILED ACTION

1. This is the first office action for serial number 10/618,275. This application contains 24 claims numbered 1-11 and 13-25.
2. Currently, the claim 12 is not in the original disclosure. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 13-25 been renumbered as 12-24.

3. Applicant's election with traverse of Group I, the species of Figures 1-5, claims 1-9, 13-17, 22 and 25 (which is now renumbered as claims 1-9, 12-16, 21 and 24 respectively) in the reply filed on 11/17/04 is acknowledged. The traversal is on the ground that the multiple species is insupportable and inconsistent with the clear statements from the specification. Although this argument is not found persuasive because Applicant did not point out clearly what statement from the specification that supports the transversal. It should be noted that on page 9 of the specification, paragraph 0036, indicates that Figures 6-7 are an alternative embodiments of the invention. The examiner, however, has reconsidered the argument and that Figures 1-7 can be treated as one species, which comprises figures 1-7. Accordingly, the species requirement on Figures 1-5 and Figures 6-7 is therefore withdrawn. Claims 1-16 and 21-24 will be examined as follows:

4. Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
5. IDS filed 11/21/2003 has been reviewed and considered.

Specification

6. Page 1, line 4 of the specification, "application No. 10/080,341" should be updated to be as patent No. 6,666,414.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 12-16, 21 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,666,414. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the application are claiming

common subject matter. All elements recited in the instant claims are also recited in claims 1-17 of Patent No. 6,666,414. Both set of claims are drawn to a mounting bracket for a device.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-11, 12-16 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,823,495 to Joss et al.

Regarding claim 1, Joss et al. teaches a mounting bracket for a device comprising: a deforming element (120) (Figs. 1-2) configured from a resiliently-deformable surface (104), wherein said deforming element increases a deformability of said resiliently-deformable surface; and a pair of attachment members (107) disposed on opposite sides of and attached to said surface and adapted to interface with the device upon deformation of said deforming element. Note that the surface (104) is inherently deformable since virtually anything will be deformed if enough pressure is applied to it.

See Fredman V. Harris-Hub Co., Inc, 163 USPQ 397 (DC 1969).

Regarding claim 2, said each of said attachment members comprises fastener attachment sites (112, 115) for receiving fasteners for interfacing said attachment members with the device upon deformation of said deforming element.

Regarding claim 3, said deforming element comprise one or more compression elements (120, 122).

Regarding claim 4, said deforming element comprises a substantially serpentine metal strip (120).

Regarding claim 5, said deforming element comprises a portion of said surface adapted to provide a spring element.

Regarding claim 6, said deforming element is adapted to provide linear deformation of said surface.

Regarding claim 7, said deforming element of said surface is compressed to bring said attachment members into contact with said device.

Regarding claims 10-11, Joss et al. also teaches a thermal interface material disposed between the attachment member and the device and the thermal interface material is a thermally-conductive elastomer sheet material (114, 115) (Col. 2, lines 5-54)

Regarding claim 12, said device is capable of holding a computer storage device. Note that this claim recites an intended use as set out in the preamble, which has given no patentable weight.

Regarding claim 13, said mounting bracket comprises screw holes defined in said attachment members.

Regarding claim 14, said resiliently-deformable surface is deformed by action of screws inserted through said screw holes into said device.

Regarding claim 15, said resiliently-deformable surface (104) comprises a compressible lateral midline portion connecting opposing outer lateral portions of said surface (108, 109 or 120).

Regarding claim 16, said resiliently-deformable surface includes a flat spring midline portion connecting opposing outer lateral portions of said surface (120).

Regarding claim 21, Joss et al. also teaches the device comprising: a mounting bracket constructed from a thermal conductor', sidewalls on said mounting bracket constructed from said thermal conductor; and fastening receptacles (112, 115) within said sidewalls for securing said device, wherein said fastening creates a thermal interface between said device and said sidewalls.

Regarding claims 22-23, Joss et al. also teaches a thermal interface material (114) disposed between the attachment member and the device and the thermal interface material is a thermally-conductive elastomer sheet material (114) (Col. 2, lines 5-54)

Claims 1-4, 6-9, 12, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,344,032 to Ramsdell.

Regarding claim 1, Ramsdell teaches a mounting bracket for a device comprising: a deforming element (20) configured from a resiliently-deformable surface wherein said deforming element increases a deformability of said resiliently-deformable surface; and a pair of attachment members (19) disposed on opposite sides of and attached to said surface and adapted to interface with the device upon deformation of said deforming element.

Regarding claim 2, said each of said attachment members comprises fastener attachment sites (18) for receiving fasteners (21) for interfacing said attachment members with the device upon deformation of said deforming element.

Regarding claim 3, said deforming element comprise one or more compression elements (walls 20 for example).

Regarding claim 4, said deforming element comprises a substantially serpentine metal strip.

Regarding claim 6, said deforming element is adapted to provide linear deformation of said surface.

Regarding claim 7, said deforming element of said surface is compressed to bring said attachment members into contact with said device.

Regarding claim 8, said deforming element is comprised of machined aluminum alloy.

Regarding claim 9, said attachment members are comprised of aluminum alloy (Col. 2, lines 5-20).

Regarding claim 12, said device is capable of holding a computer storage device. Note that this claim recites an intended use as set out in the preamble, which has given no patentable weight.

Regarding claim 21, Ramsdell also teaches the device comprising: a mounting bracket (19) constructed from a thermal conductor', sidewalls on said mounting bracket constructed from said thermal conductor; and fastening receptacles (18, 21) within said sidewalls for securing said device, wherein said fastening creates a thermal interface between said device and said sidewalls.

Regarding claim 24, said thermal conductor comprises aluminum alloy (see col. 2, lines 5-20)

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,666,414 to Dean et al.

6,616,106 to Dean et al.

5,779,197 to Kim

5,828,547 to Francovich et al.

5,682,291 to Jefferies et al.

5,262,923 to Batta et al.

The above patents disclose various types of mounting bracket for mounting an audio or computer device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244. The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
Patent examiner
February 4, 2005.



RAMON O. RAMIREZ
PRIMARY EXAMINER